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EXAMINER

SHERR, CRISTINA O

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3685

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/868,435	Applicant(s) DOLL-STEINBERG, DANIEL	
	Examiner CRISTINA SHERR	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-31 and 50-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-31 and 50-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to Applicant's Amendment filed March 26, 2009. Claims 26-31 and 50-76 are currently pending in this case. Claims 26 and 50 are currently amended.

Response to Arguments

2. Applicant's arguments with respect to claims 26 and 50, as currently amended, have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 50-73 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

5. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

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6. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

7. In this particular case, claim 50 fails prong (1) because the "tie" (e.g. the point of sale or whatever is "preventing" and "enabling") is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claims 51-73 are also rejected as each depends from claim 50.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 26-31, 50-69, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolphin (US 5,457,746) in view of Katz et al (US 5,926,624).

10. Regarding claim 26 –

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11. Dolphin discloses a digital media production system for manufacturing on demand at a local site digital information products on physical media, the system comprising:

(a) a local mass data storage device at the local site storing digital information for a plurality of different digital information products; (e.g. col 2 ln 55-56, fig 2/31, where digital information is being stored on the publisher's computer or similar local site) and
(b) a local release unit connected to a user interface and an output, the user interface receiving a request from a customer for a selected digital information product including the physical media carrying that selected digital information product, and the output issuing a product release request to a remote licensing control center; (e.g. col 4 ln 55-67)

(c) a local control unit arranged to:

i. receive a unique electronic release code issued in response to the product release request from the remote licensing control center authorizing physical production of the selected digital information product and thereafter to enable complete generation of the selected digital information product; (e.g. col 5 ln 7-16 where publisher's local computer with access code on PCMCIA creates CD-ROM with digital data and access code or key for decrypting data on the CD-ROM) and

(d) a local media generator generating the selected digital information product by storing on the physical media the digital information and by recording on the physical media the issued unique release code; (e.g. col 5 ln 7-16 where publisher's local computer with

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access code on PCMCIA creates CD-ROM with digital data and access code or key of the data on the CD-ROM).

12. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

13. Katz discloses, as Dolphin does not, preventing complete generation of any digital information product before receipt of the unique electronic release code issued by the remote licensing control center (col 11 ln 32 – col 12 ln 16, where processing only continues if both systems are authorized systems).

14. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Dolphin and Katz in order to prevent unauthorized usage of digital media by employing a license on a remote server.

15. Regarding claim 27 –

16. Dolphin discloses wherein the unique release code includes a license number; and in which the packaging generator is arranged to print at least one of the license number and the customer's name onto the media packaging, (e.g., col 5 ln40-45 col 5 ln 57-60

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17. where attributes are used to define charges for access to data or manner of use of data, e.g. “on demand” or “one time” and attribute is bound to the decryption key or release code col 6 ln 11-15).

18. Regarding claim 28 –

19. Dolphin does not specifically teach wherein the unique release code includes a license number; and in which there is further included a certificate of authenticity generator arranged to generate a certificate of authenticity including at least one of the license number and the customer's name. However, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer's name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

20. Regarding claim 29 –

21. Dolphin suggests wherein a media generator is arranged to include a user-defined personalization applied to at least one of the surface of the media, and the digital information stored on the media. (Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a

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predictable result to somehow make the CD-ROM suitable for mailing via US mail.

Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)., Where the container, would include , *inter alia*, the recipient's address and name, both of which are defined by the user.

Also, e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and thus would likely include such identifying information as license numbers, names, addresses, etc).

22. Regarding claim 30 –

23. Dolphin discloses wherein a media generator includes a media writer. (e.g. col 4 ln 25-30, how else to store data on a CD-ROM and the send it away by U.S. mail if not by media writer of one sort or another?).

24. Regarding claim 31 –

25. Dolphin discloses wherein the product release code includes a license number, and in which the media generator includes a printer arranged to print onto a surface associated with the selected digital information product at least one of the license number and the customer's name. (e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and thus would likely include such identifying information as license numbers, names, addresses, etc. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the

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data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Such container would normally include providing some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name, both of which are defined by the user. Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer's name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

26. Regarding claim 76 –

27. Dolphin discloses a system in which the input means are further for input of a request from the customer for including in the selected product customer-personalized information and for input of details concerning the personalized information, and the output means are further for issue of data representing the personalized information, and in which the said local control unit is responsive to the data representing the personalized information to control application of the information to the selected product and the media generator is arranged to include the personalized information in the selected product. (Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col

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7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer’s name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

28. Regarding claim 50 –

29. Dolphin discloses a method of manufacturing on demand at a point of sale digital information products on physical media comprising:

(a) receiving, at the point of sale, input of a request from a customer for a selected digital information product including the physical media carrying the selected digital information product; (e.g. col 2 ln 55-56, fig 2/31, where digital information is being stored on the publisher’s computer or similar local site)

(b) issuing, from the point of sale, to a remote licensing control center a product release request to issue a unique release code electronically; ; (e.g. col 5 ln 7-16 where publisher’s local computer with access code on PCMCIA creates CD-ROM with digital data and access code or key for decrypting data on the CD-ROM)

(d) obtaining, at the point of sale, the unique release code from the remote licensing control center in response to the issued product release request; (e.g. col 5 ln 7-16 where publisher’s local computer with access code on PCMCIA creates CD-ROM with digital data and access code or key for decrypting data on the CD-ROM)

(e) authorizing physical production of the selected digital information product at the point of sale in response to the obtained unique release code by enabling complete

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generation of the selected digital information product; (e.g. col 5 ln 7-16 where publisher's local computer with access code on PCMCIA creates CD-ROM with digital data and access code or key for decrypting data on the CD-ROM)

(f) generating the selected digital information product, at the point of sale, by storing on the physical media the digital information and by recording on the physical media the unique release code. (e.g. col 5 ln 7-16 where publisher's local computer with access code on PCMCIA creates CD-ROM with digital data and access code or key for decrypting data on the CD-ROM)

30. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Such container would normally include providing some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address.

31. Katz discloses, as Dolphin does not, preventing complete generation of any digital information product before receipt of the unique electronic release code issued by the remote licensing control center (col 11 ln 32 – col 12 ln 16, where processing only continues if both systems are authorized systems).

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32. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine Dolphin and Katz in order to prevent unauthorized usage of digital media by employing a license on a remote server.

33. Regarding claim 51 –

34. Dolphin discloses wherein the unique release code is associated with the customer. Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer’s name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

35. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Such container would normally include providing some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name, both of which are defined by the user. Also, e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and

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thus would likely include such identifying information as license numbers, names, addresses, etc).

36. Regarding claim 52 –

37. Dolphin discloses wherein the media includes packaging; the release code includes a license number; and the license number is printed onto the packaging. Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer’s name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

38. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Such container would normally include providing some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name, both of which are defined by the user. Also, e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and

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thus would likely include such identifying information as license numbers, names, addresses, etc).

39. Regarding claim 53 –

40. Dolphin discloses a method in which the customer's name is printed onto the packaging. (e.g. col 4 ln 25-38, in Dolphin, where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail it would be obvious to one of ordinary skill in the art that the publisher is somehow making the CD-ROM suitable for mailing via US mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Such container would normally include some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name.)

41. Regarding claim 54 –

42. Dolphin discloses a method in which the unique release code is electronically stored on the media along with the customer-selected information. (e.g. col 6 ln 11-15, it is obvious that the KMID of Dolphin is used to show authenticity and thus would likely include such identifying information, defined by the user, as license numbers, names, addresses, etc).

43. Regarding claim 55 –

44. Dolphin discloses a method in which information representative of the customer is electronically stored on the media. (e.g. col 6 ln 11-15, it is obvious that the KMID of

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Dolphin is used to show authenticity and thus would likely include such identifying information as license numbers, names, addresses, etc).

45. Regarding claim 56 –

46. Dolphin discloses a method in which the unique release code includes a license number and the license number is printed onto a surface associated with the selected product. (Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer’s name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

47. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result in light of Dolphin to provide a mail envelope, box, or similar container for the CD-ROM to be delivered to the user. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). Such container would normally include providing some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name, both of which are defined by the user. Also, e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and

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thus would likely include such identifying information as license numbers, names, addresses, etc).

48. Regarding claim 57 –

49. Dolphin discloses a method in which the customer's name is printed onto the surface associated with the selected digital information product. (e.g. col 4 ln 25-38, in Dolphin, where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail it would be obvious to one of ordinary skill in the art that the publisher is somehow making the CD-ROM suitable for mailing via US mail. Such suitability would normally include some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name. Further, it would be predictable to go ahead and print whatever is helpful on the package or surface of the media, not only a name and address, but license number or anything else you want.)

50. Regarding claim 58 –

51. Dolphin discloses a method including producing a certificate of authenticity at the point of sale containing the release code. (e.g. col 5 ln 7-16 where publisher's local computer with access code on PCMCIA creates CD-ROM with digital data and access code or key for decrypting data on the CD-ROM)

52. Regarding claim 59 –

53. Dolphin suggests a method including adding the customer's name to the certificate of authenticity. (Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit”

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= “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer’s name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

54. . Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result to somehow make the CD-ROM suitable for mailing via US mail. Such suitability would normally include providing some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name, both of which are defined by the user. Also, e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and thus would likely include such identifying information as license numbers, names, addresses, etc).

55. Regarding claim 60 –

56. Dolphin suggests a method including receiving from the customer at the point of sale a user-defined media personalization, and adding the personalization to the media. (Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or

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“license”. It would be a predictable result to attach a customer’s name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

57. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result to somehow make the CD-ROM suitable for mailing via US mail. Such suitability would normally include providing some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name, both of which are defined by the user. Also, e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and thus would likely include such identifying information as license numbers, names, addresses, etc).

58. Regarding claim 61 -

59. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, in Dolphin, where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail it would be obvious to one of ordinary skill in the art that the publisher is somehow making the CD-ROM suitable for mailing via US mail. Such suitability would normally include some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name, which would thus personalize the packaging.

60. Regarding claim 62 –

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61. Dolphin suggests a method in which the personalization is electronically stored on the media along with the customer-selected digital information. (Also, at, e.g. col 6 ln 11-15, the KMID (key material identifier) of Dolphin is used to show authenticity and positively identify a data set. Note also at, col 7, ln 14-20, col 8 ln 10-15, col 11 ln 24-32, col 11 ln 65-col 12 ln 3, where the “audit” = “certificate” such that the KMID is tied to certain “attributes” (see col 5 ln 10-25) such as a “subscription” or “license”. It would be a predictable result to attach a customer’s name to an audit (col 11 ln 25-32). *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

62. Dolphin does not specifically disclose a packaging generator producing physical media packaging for the selected digital information product for packaging the physical media for supply to the customer. However, at col 4 ln 25-38, Dolphin does teach where the publisher, 21, distributes the data on CD—ROM via the US Post Office, or interoffice mail. Therefore, it would be a predictable result to somehow make the CD-ROM suitable for mailing via US mail. Such suitability would normally include providing some kind of physical mailing envelope labeled with, *inter alia*, the recipient's address and name, both of which are defined by the user. Also, e.g. col 6 ln 11-15, it is predictable that the KMID of Dolphin is used to show authenticity and thus would likely include such identifying information as license numbers, names, addresses, etc).

63. Regarding claim 63 –

64. Dolphin discloses a method in which the unique release code is issued at the licensing control center and is sent electronically to the point of sale on receipt of the customer request. (e.g. col 2 ln 55-56, col 4 ln 65-67 fig 2-23, where remote

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billing/access center provides the access code, equivalent to unique release code so that the data may be decrypted or released) ;

65. Regarding claim 64 –

66. Dolphin discloses a method including storing at the point of sale a plurality of customer requests, receiving at the licensing control center the plurality of customer requests; and issuing from the licensing control center and sending to the point of sale a plurality of unique release codes in response to the plurality of customer requests. (e.g. col 2 ln 55-56, col 4 ln 65-67 fig 2-23, where remote billing/access center provides the access code, equivalent to unique release code so that the data may be decrypted or released)

67. Regarding claim 65 –

68. Dolphin discloses a method as claimed in claim 50 in which a plurality of unique release codes are issued at the licensing control center and transmitted electronically in advance to the point of sale, one of the unique release codes being associated with the customer on receipt of the customer request. (e.g. col 7 ln 48-57, note that here, there is the option of having the release codes, equivalent to key in Dolphin already on the card, so that they need not be requested from the remote database).

69. Regarding claim 66 –

70. Dolphin discloses a method including keeping a cumulative record at the point of sale of all supplied media and associated unique release codes, and forwarding the record electronically to the licensing control center. (e.g. col 8 ln 53-67).

71. Regarding claim 67 –

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72. Dolphin discloses a method in which the customer request is made by a customer not physically present at the point of sale. (e.g. col 4 ln 23-38)

73. Regarding claim 68 –

74. Dolphin discloses a method in which the customer request is made by a customer not physically present at the point of sale, via a communications medium, with the media being prepared at the point of sale for later collection by or delivery to the customer. (e.g. col 4 ln 23-38)

75. Regarding claim 69 –

76. Dolphin does not specifically disclose a method further including receiving a request from the customer for a student sale, the request including a student number; validating the student number with reference to a representation of valid student numbers; and authorizing the student sale depending upon the validation. However, it would be obvious to one of ordinary skill in the art that the KMID of Dolphin is used to show authenticity and thus would likely include such identifying information as names, addresses, or anything else that might be helpful such as student numbers, license numbers, and so forth and that they must be shown to be valid. (e.g. col 6 ln 11-15)

77. Regarding claim 71 –

78. Dolphin discloses a method as claimed in claim 50 further including storing a code at the point of sale or at the licensing control center; and precoding the media with the code before storage of the customer selected information. (e.g. col 7 ln 48-57, note that here, there is the option of having the release codes, equivalent to key in Dolphin already on the card, so that they need not be requested from the remote database.)

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79. Claims 70, and 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolphin (US 5,457,746) in view of Katz et al (US 5,926,624) further in view of Grundy (US 5,291,598).

80. Dolphin and Katz disclose as discussed.

81. Regarding claim 70 –

82. Grundy discloses receiving a request from the customer for an upgrade sale, the request including a previous license number; validating the previous license number with reference to a representation of valid previous license numbers; and authorizing the upgrade sale depending upon the validation. (fig 2b).

83. Regarding claim 72 –

84. Grundy discloses a method in which the code is unique to the fulfillment unit. (fig 2, fig 4).

85. Regarding claims 73-75 –

86. Grundy discloses a method further including receiving from the customer a request including a user-defined selection of products; and storing at the point of sale the request for user-defined selection of products for access by the customer, in which the user-defined selection of products comprises a gift list, and in which the user-defined selection of products comprises a list compiled by an educational establishment. (fig 6). Note that it would be obvious to make any type of list of ownership records or any type of selection of products, including but not limited to gift lists, and school lists.

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87. It would have been obvious to one of ordinary skill in the art to combine Dolphin, Katz and Grundy since both are in the field of software manufacture and duplication and personalization is a standard technique in sales.

Conclusion

88. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

89. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

90. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

91. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

92. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR
Examiner
Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685

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